

Remarks

Claims 1-20 are pending in this application. Claims 10 and 16 have been amended. Claims 1, 10 and 17 are independent claims.

In an Office action dated January 8, 2003, claims 1, 4, 7-8, 17 and 19-20 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Tombetti in view of Sells et al., with claims 2 and 3 being rejected further in view of Dunn et al. and claims 5, 6, 9 and 18 being rejected further in view of Kikinis et al. Claims 10 and 16 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Tombetti in view of Kikinis et al., with claims 11 and 12 being rejected further in view of Sells et al. and claims 13-15 being rejected further in view of Yeh et al.

In response to the rejections of the claims, independent claim 10 and dependent claim 16 have been amended. Amended claim 10 more clearly states that the data is stored in only one of the telephone and the computer. Claim 16 states that the processing means of the computer has superior processing capability as compared to the processing means of the telephone. Support for the amendments may be found on page 3, lines 14-18 of the application as originally filed. In this portion of the application, it is stated that by utilizing the relatively large memory capacity of the computer to store excess call-related data, such as voicemail messages, and by utilizing the relatively high sophistication of the computer to perform intensive data processing functions, such as voice recognition, the capability of a telephone can be significantly extended.

The amendments to claims 10 and 16 patentably distinguish the claims from the combined teachings of Tombetti and Kikinis et al. The Office action correctly notes that Tombetti does not teach either (1) means for enabling the telephone to automatically determine without user input whether the data received at the telephone will be maintained at the telephone or transferred to a computer or (2) means for transferring the data between the telephone and the computer. Rather, Kikinis et al. teaches the use of modules that dock with a phone. For example, the Office action cites columns 15 through 17 of Kikinis et al., which describe the use of a

micropersonal digital assistant (μ PDA) that docks with a portable computer or desktop computer. Since the μ PDA does not have superior storage or superior processing capability, the combination of Tombetti and Kikinis et al. does not render amended claims 10 and 16 obvious under Section 103(a).

A. Relevance of Previously Filed Remarks

On page 17 of the Office action, in the section entitled "Response to Arguments," it was alleged that Applicants' earlier filed remarks are now "moot in view of the new grounds of rejection." Applicants respectfully object. The rejections of claims 1 and 17 continue to rely upon a combination of teachings that cannot coexist. Similar to many issued patents, the Tombetti patent describes a prior art approach, describes the shortcomings of the prior art approach, and describes the claimed invention for overcoming the shortcomings. In Tombetti, the described prior art approach was to have separate computer and phone systems (Fig. 1, as set forth in column 3), while the inventive solution was to provide a modular multimedia phone (shown in Fig. 2). While the teachings regarding the multimedia phone of Fig. 2 are in direct conflict with the teachings regarding the prior art approach of Fig. 1, the rejection of the independent claims switches between citing the contradictory teachings, without acknowledging that the teachings are logically incompatible.

Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) states that the "test of obviousness" is based upon what the combined teachings of the references would have suggested to one of ordinary skill in the art, "and all teachings in the prior art must be considered to the extent that they are in analogous arts." It is then stated, "Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another," citing In re Young, 18 USPQ2d 1089 (Fed. Cir. 1991). In the rejection of claims 1 and 17, teachings of the same patent (Tombetti) conflict. Nevertheless, the existence of the conflict is not addressed in the Office

action. Instead, portions of the Tombetti patent are cited as if they fit logically together as a cohesive whole. Applicants respectfully assert that this is contrary to a proper Section 103(a) determination, so that a *prima facie* case of obviousness has not been presented.

Applicants respectfully contend that the teachings of column 3 in Tombetti must be considered separately from the description of the invention of Tombetti, since the person of ordinary skill in the art would consider the two conflicting approaches separately. Consequently, the separate approaches will be considered in the two subsections that follow.

1. The Teachings of Column 3 in Tombetti in View of Sells et al.

The Office action cites various portions of column 3 of Tombetti as being relevant to the determination of patentability of Applicants' claimed invention. The teachings of column 3 refer to the "prior art" approach shown in the block diagram of Fig. 1 in Tombetti. In Fig. 1, a telecommunications terminal 10 (telephone) is coupled to a communication line 14. Through the telecommunication line, the telephone can be used to send audio signals to and receive audio signals from a user 16, which presumably is a second telephone. In addition, the telephone 10 can communicate with a computer 18 through the communication line 14.

The patent identifies the shortcomings of having two systems that function separately (Tombetti: column 3, lines 51-64). The computer system is relatively expensive and may be difficult to use for an unsophisticated user. On the other hand, the patent states that the telephone has limited functionality and typically cannot support peripherals. Clearly, this description of computer and telephone systems that function separately does not teach or suggest Applicants' claimed invention, in which a determination is made within a telephone as to whether first call-related data will be stored in telephone memory or computer memory (method claim 1) or in which the automated processing capabilities of the telephone are used to determine whether the call-related data will be processed at the telephone or at the computer (method claim 17).

The Office action cites lines 32-49 in column 3 of Tombetti. This portion of the patent states that the telephone 10 has limited functionality in accessing an online service, so that a separate computer is frequently used to send and receive data over a communication line 14. In addition to processing data and accessing remote services, the separate computer (not shown) is capable of supporting a variety of other devices, such as a personal digital assistant. However, the patent does not state that the computer supports the telephone 10. More importantly, the patent does not state that the telephone determines data storage of the computer (claim 1) or data processing by the computer (claim 17).

Sells et al. was cited for allegedly teaching alternative storage of call-related data in memory located within a computer, in order to transfer control of the telephone line to the appropriate telephony application program. Column 8, lines 59-62 of Sells et al. are cited for this feature. Applicants respectfully submit that the teachings of Sells et al. have not been properly applied to the claim language of the pending claims, so that a *prima facie* case of obviousness has not been presented. For example, in claim 1, it is stated that the telephone is enabled to store the call-related data in memory located within the telephone, while the computer is enabled to alternatively store the call-related data in memory located within the computer. Thus, the alternative storage relates to telephone memory and computer memory. On the other hand, the Office action refers to the teachings of Sells et al. regarding alternative storage within the same computer. Teachings regarding alternative storage within a single computer do not suggest to a person of ordinary skill in the art that there should be alternative storage between a telephone memory and a computer memory, as set forth in the pending claims.

The Office action cites column 3, lines 59-65 of Sells et al. for teaching alternative storage. However, this portion of the patent merely refers to components of the computer 12 of Fig. 1. Specifically, the cited portion of Sells et al. states that the personal computer 12 includes a central processing unit 32, a memory subsystem 31, and a telephony subsystem 14. Since column 3, lines 59-65 of Sells et al. identify components of the computer, the

cited portion does not teach or suggest enabling a telephone to store call-related data in memory located within the telephone.

The Office action also cites column 8, lines 59-62 of Sells et al. This portion of the patent merely states that a single computer includes a number of different application programs and that a telephone manager program 104 is used to transfer the telephone line to the appropriate telephony application program when an incoming call is received. Applicants assert that this teaching regarding the alternative capability within a single computer does not render it obvious to enable a telephone to store call-related data in telephone memory and to also enable a computer to alternatively store the call-related data in computer memory. Thus, the combination of teachings of Tombetti and Sells et al. does not present a *prima facie* case of obviousness under Section 103(a).

Additionally, claims 1 and 17 specifically state that the telephone determines whether the call-related data will be stored in telephone memory or computer memory (claim 1) or determines whether call-related data will be processed at the telephone or at the computer (claim 17). On the other hand, column 3 of Tombetti specifically states that the computer system and the telephone system function separately (Tombetti: column 3, lines 50-52) and Sells et al. teaches that it is the computer that controls the telephone (Sells et al.: column 4, lines 48-50). Thus, the prior art teaches away from the claimed invention, indicating the patentability of the pending claims.

Since the combination of teachings of column 3 of Tombetti and the teachings of Sells et al. does not teach the claimed invention, it is respectfully submitted that independent claims 1 and 17 and their dependent claims are in an allowable condition.

2. The Combination of the Invention of Tombetti and the Teachings of Sells et al.

In the above subsection, references were made to the teachings of Tombetti regarding previously known approaches, which were described in column 3 of the Tombetti patent. The invention of Tombetti was to provide a multimedia phone, as illustrated in Fig. 2 of the patent. This single-unit invention does not teach or suggest the claimed invention.

The Office action cites column 5, lines 50-65 of Tombetti for being relevant to Applicants' claimed step of determining, within the telephone, whether the first call-related data will be stored in the telephone memory or the computer memory. This portion of the patent states that the single-unit system 100 of Fig. 2 can be adapted to perform a variety of other tasks typically performed by a computer. Thus, the teachings of Tombetti relate to replacing the need for a computer, rather than relating to being cooperative with a computer in the manner described in claims 1 and 17. Since lines 50-65 in column 5 of Tombetti refer to using the telephone to perform tasks typically performed by a computer, the cited portion does not teach or suggest determining within a telephone whether call-related data should be stored or processed at a computer. The patent states that the single-unit system 100 of Fig. 2 may be used with a cellular telephone or pager, but the patent does not teach or suggest enabling the cellular telephone or pager to determine whether call-related data is to be stored or processed within the single-unit system 100 or the cellular telephone/pager. It is asserted that the patent does not render the claimed invention obvious under Section 103(a).

The Office action also cites column 8, lines 29-35 of Tombetti as being particularly relevant. This portion of the patent merely states that the single-unit system 100 of Fig. 2 may include plug-in memory, such as memory on a FLASH PC card or RAM PC card. Applicants point out that this is merely additional memory, rather than a cooperation between a telephone and a computer, as described in pending claims 1 and 17. A person of ordinary skill in the art would not consider a memory card to be a "computer" having

memory located within the computer for alternatively storing call-related data (claim 1) or a computer having a resident processor for processing call-related data received at the telephone.

Sells et al. was cited for teaching alternatively storing call-related data. The above remarks regarding the teachings of Sells et al. apply equally to this combination of teachings of Sells et al. with teachings of the Tombetti invention (rather than with the teachings in Tombetti regarding prior approaches). Briefly, the Sells et al. patent does not teach alternative storage, since the telephone 15 is not described as having internal memory for storing call-related data. Additionally, the patent specifically states that the computer controls calls, rather than determinations being made at the telephone (Sells et al.: column 4, lines 48-50). Sells et al. is cited for teaching the transfer of control of a telephone line to the appropriate telephony application program (column 8, lines 59-62), but all of the telephony application programs are programs loaded into the computer. Therefore, there is no transfer of control from the telephone to the computer. Again, Applicants submit that a *prima facie* case of obviousness has not been presented.

Reconsideration of independent claims 1 and 17 is respectfully requested.

B. Patentability of Claims 10-16

Independent claim 10 and dependent claim 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti in view of Kikinis et al. As previously noted, claim 10 has been amended to state that components of the apparatus are cooperative to store data at only one of the telephone and the computer. That is, there is not duplicative storage. Dependent claim 16 has been amended to state that the processing means of the computer has superior processing capabilities as compared to the processing means of the telephone. Applicants respectfully submit that the amendments to the claims patentably distinguish claims 10-16 from the cited prior art.

Tombetti was cited for teaching a telephone having the capability of receiving data from a telephone network and the capability of storing the data. The Office action correctly points out that Tombetti does not teach an enabling means of the telephone for automatically determining whether the data received at the telephone will be maintained at the telephone or transferred to a computer. It is also pointed out that Tombetti does not teach a means for transferring the data between the telephone and the computer.

MPEP 2143.01 states, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious," citing *In re Ratti*, 123 USPQ 349 (CCPA 1959). The principle of operation of the primary patent to Tombetti is to overcome the "drawbacks" associated with the need to have a computer system and a phone system (Tombetti: column 3, lines 50-64). Tombetti states that the drawbacks are overcome by providing the master unit shown in Fig. 2 of the patent. Consequently, modifying the Tombetti teachings to more closely approach the apparatus described in the pending claims would not be *prima facie* obvious to a person of ordinary skill in the particular art.

Thus, the rejection of claim 10 contradicts the procedure set forth in the MPEP for establishing a *prima facie* case of obviousness. Equally importantly, the proposed motivation for modifying the teachings of Tombetti contradicts the description of the Tombetti patent. The Office action asserts that modifying Tombetti to incorporate teachings of Kikinis et al. would be obvious, since the combination would add digital telephone capability. However, as specifically stated in column 5, lines 50-52 of Tombetti, the system 100 of Fig. 2 may be provided with digital telephone capability. Since the Tombetti system is configurable to include digital telephone capability, it would not be obvious to disregard the principle of operation of the Tombetti system to "add" digital telephone capability. A *prima facie* case of obviousness has not been established by the citation of the two prior art references.

In view of the amendments to claims 10 and 16, Applicants submit that the claims are patentably distinguished from the prior art.

C. Citation of the Patent to Yeh et al.

The Yeh et al. patent was cited only with regard to the subject matter of dependent claims 13-15. These claims relate to the description of the apparatus as being one in which the computer lacks computer telephony capability. The remarks made with regard to the Yeh et al. patent in the previously filed amendment apply equally herein and are incorporated by reference. Briefly, it would not be obvious to modify the Tombetti system 100 of Fig. 2 in a manner that would prevent the Tombetti system from operating as intended. Applicants respectfully request that the Examiner provide an explanation as to why it would be obvious to greatly reduce the capabilities of the Tombetti system 100. It is submitted that the issue of disregarding critical teachings of Tombetti is not rendered "moot" by the citation of the Dunn et al. patent as applied to unrelated claims (i.e., claims 2 and 3).

Moreover, as asserted on page 11 of the previously filed amendment, the Office action evidences a fundamental misunderstanding of the teachings of Yeh et al. It is inaccurate to state that Yeh et al. teaches that a computer lacks computer telephony capability in order to provide various telephone functions on the computer with user friendly interfaces using programmable software, and computer and telephone hardware. Reconsideration of claims 13-15 is respectfully requested.

D. Citation of the Patent to Dunn et al.

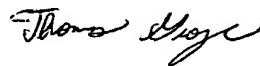
The Dunn et al. patent was cited as being relevant to the patentability of dependent claims 2 and 3. In pending claim 2, the method is described as including the step of establishing a direct connection between the telephone and the computer, which are structurally separate components. In rejecting this claim, it is correctly noted that Tombetti does not show the telephone and computer as being structurally separate components. In fact,

Applicants point out that the principle of operation of the Tombetti patent is to provide a master unit of the type shown in Fig. 2, which provides both computing and telephony capabilities. It is asserted in the Office action that it would be obvious to modify the teachings of Tombetti to incorporate features of Dunn et al. "in order to selectively provide a computer control to a digital feature phone as suggested by Dunn et al." Applicants submit that this is not supported by the primary patent to Tombetti. That is, there is no motivation for attaching a separate digital feature phone to the Tombetti patent, which may function itself as a digital feature telephone. The Tombetti patent states in column 5, lines 50-54 that the system 100 uses digital lines and states in column 4, lines 15-46 that the benefit of the invention is that it is easily upgraded to a system which may provide a variety of functions, such as video conferencing, Internet accessing, and electronic mail retrieval. A person of ordinary skill in the art would not be motivated to modify Tombetti to connect a digital feature telephone to a multimedia phone system having digital feature telephone capability. Reconsideration of the claims is respectfully requested.

Attached hereto is a complete listing of the claims in this patent application. The status of each claim is indicated, in accordance with the proposed revision to 37 CFR 1.121 (Manner of Making Amendments).

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can be resolved expeditiously via a telephone conversation, Applicants invite the Examiner to call Terry McHugh at (650) 969-8458.

Respectfully submitted,



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COMPLETE LISTING OF ALL CLAIMS IN THE APPLICATION

1 1. A method for extending a telephone's capability comprising steps of:
2 enabling a telephone to store call-related data in memory
3 located within said telephone;
4 enabling a computer to alternatively store said call-related data
5 in memory located within said computer;
6 receiving first call-related data at said telephone;
7 recognizing that said first call-related data is to be stored in
8 memory;
9 determining, within said telephone, whether said first call-related
10 data will be stored in said telephone memory or said computer memory; and
11 storing said first call-related data in said telephone memory or
12 said computer memory based upon said determination.

1 2. (previously amended) The method of claim 1 further including a step of
2 establishing a direct data connection between said telephone and said
3 computer, said telephone and said computer being structurally separate
4 components.

1 3. The method of claim 2 wherein said telephone and said computer are
2 located within a common workspace, said step of establishing said direct data
3 connection being independent of providing connectivity for receiving said first
4 call-related data.

1 4. The method of claim 1 wherein said telephone is enabled to perform
2 telephone functions independently of said computer.

1 5. The method of claim 1 wherein said step of determining includes steps of:
2 monitoring storage availability within said telephone memory;
3 comparing said monitored storage availability to a storage
4 threshold that is related to said telephone memory; and
5 storing said first call-related data in said computer memory when
6 said storage threshold related to said telephone memory is exceeded.

1 6. The method of claim 5 further including a step of retrieving call-related data
2 from said computer to said telephone in response to signals from said
3 telephone.

1 7. (previously amended) The method of claim 1 further including steps of:
2 enabling a first processor located within said telephone to
3 process data received at said telephone;
4 enabling a second processor located within said computer to
5 process data received at said telephone;
6 recognizing that said first call-related data received at said
7 telephone is to be processed; and
8 determining, within said telephone, whether said first call-related
9 data will be processed by said first processor or said second processor, said
10 telephone thereby controlling said first call-related data with respect to which
11 of two structurally separate components will perform processing thereon.

1 8. The method of claim 1 further including a step of utilizing a processor of
2 said computer to process at least a portion of said first call-related data in
3 response to instructions from said telephone.

1 9. The method of claim 1 further including a step of establishing a data con-
2 nection between said telephone and said computer by connecting said
3 telephone separately to a telephone network and to said computer.

1 10. (amended) An apparatus for extending the capability of a telephone
2 comprising:
3 means, located within said telephone, for receiving data from a
4 telephone network;
5 means, located within said telephone, for storing said data
6 received from said telephone network;
7 means, operatively associated with said means for receiving,
8 for enabling said telephone to automatically determine without user input
9 whether said data received at said telephone will be maintained at said
10 telephone or transferred to a computer; and
11 means, operatively associated with said telephone, for trans-
12 ferring said data between said telephone and said computer, wherein said
13 means for enabling and said means for transferring are cooperative to store
14 said data at only one of said telephone and said computer.

1 11. The apparatus of claim 10 further including:
2 means, located within said computer, for storing said data
3 received from said telephone; and
4 means, located within said telephone, for determining whether
5 data received at said telephone from said telephone network will be stored
6 within said telephone storage means or said computer storage means.

1 12. The apparatus of claim 10 wherein said telephone is connected
2 separately to said telephone network and said computer.

1 13. The apparatus of claim 12 wherein said computer lacks computer
2 telephony capability.

1 14. The apparatus of claim 10 wherein said means for enabling is located
2 within said telephone.

1 15. The apparatus of claim 10 wherein said means for enabling includes an
2 application programming interface resident within said telephone.

1 16. (amended) The apparatus of claim 10 further including:
2 means, located within said telephone, for processing said data
3 received from said telephone network;
4 means, located within said computer, for processing said data
5 received from said telephone, said processing means of said computer having
6 superior processing capabilities as compared to said processing means of
7 said telephone; and
8 means, located within said telephone, for determining whether
9 said data received at said telephone from said telephone network will be
10 processed within said telephone processing means or said computer
11 processing means.

1 17. (previously amended) A method of extending the capability of a
2 telephone comprising the steps of:
3 enabling a first processor resident in a telephone to process
4 data received at said telephone;
5 enabling a second processor resident in a computer to process
6 data received at said telephone;
7 receiving call-related data at said telephone;
8 recognizing that said call-related data requires further process-
9 ing;
10 determining, using automated processing capabilities of said
11 telephone, whether said call-related data will be processed in said first
12 processor or said second processor, including basing said determination
13 upon automated processing performed by said telephone; and
14 processing said call-related data in either said telephone or
15 said computer based upon said determination made using said automated
16 processing capabilities.

1 18. (previously amended) The method of claim 17 further including a step of
2 establishing a direct data connection between said telephone and said
3 computer, wherein said telephone and said computer are structurally separate
4 components located within a common workspace and wherein said telephone
5 is configured to perform telephone functions independently of said computer.

1 19. The method of claim 18 further including steps of:
2 enabling said telephone to store data received at said telephone
3 in memory located within said telephone;
4 enabling said computer to store data received at said telephone
5 in memory located within said computer;
6 recognizing that said received call-related data is to be stored in
7 memory;
8 determining, within said telephone, whether said call-related
9 data will be stored in said telephone memory or said computer memory; and
10 storing said call-related data in said telephone memory or said
11 computer memory based upon said determination.

1 20. The method of claim 19 wherein said steps of determining are performed
2 by an application programming interface residing within said telephone.